UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/764,068 | 01/19/2001 | Jeff Scott Eder | | 6669 |

53787          7590          03/31/2009
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3692 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/31/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) | |
|---|---|---|---|
| **Office Action Summary** | 09/764,068 | EDER, JEFF SCOTT | |
| | Examiner | Art Unit | |
| | JENNIFER LIVERSEDGE | 3692 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>10 January 2009</u>.

2a) ☐ This action is **FINAL**.     2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>36-65 and 67-75</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>36-65 and 67-75</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/17/2008, 10/31/2008, 11/11/2008</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 08-06)     **Office Action Summary**     Part of Paper No./Mail Date 20090324-A

## DETAILED ACTION

### *Response to Amendment*

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/764,068 filed January 10, 2009.

The amendment contains previously presented claims: 42-44, 47, 53-54, 58, 60-61, 63, 65, 67-68 and 73-74.

The amendment contains amended claims: 36-41, 45-46, 48-52, 55-57, 59, 62, 64 and 69-72.

The amendment contains new claim: 75.

Claims 1-35 and 66 have been canceled.

### *Priority*

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.  The present application is a C.I.P. of both application 08/999,245 filed on December 10, 1997 and application 09/358,969 filed on July 22, 1999 (now abandoned).  It is noted that independent claims 64 and 70 are drawn to the use of xml metadata standards and schema which was not disclosed in the December 10, 1997 filing and therefore the limitations are not subject to the December 10, 1997 date.  Additionally, dependent claims 44, 51, 56, 57 do not qualify for the December 10, 1997 date as they include limitations related to xml schema.  Claims 49 and 52 are drawn to real option discount rates which was not in the

December 10, 1997 disclosure and therefore the December 10, 1997 date does not

apply to claims 49 and 52.


## Information Disclosure Statement

The information disclosure statements (IDS) submitted on October 17, 2008,

October 31, 2008 and November 11, 2008 are in compliance with the provisions of 37

CFR 1.97.  Accordingly, the information disclosure statements are being considered by

the examiner.


## Claim Objections

Claim 72 is objected to because of the following informalities:  claim 72 recites in

part "transforming at least a portion of the data into a model each of one or more

categories…".  It is believed that this portion contains a grammatical error as the claim

is not clear.  Appropriate correction is required.


## Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 64-65 and 67-69 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement.  The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites new matter with respect to "a physical object or substance". The term is not found within the specification and therefore is improper to use within the claim limitations. Each claim limitation needs to be supported by a particular section in the specification in order to comply with the written description requirement.

Claims 70-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite new matter with respect to "an integrated database" and with respect to the limitation "output said database". Neither of the terms are found within the specification and therefore are improper to use within the claim limitations. Each claim limitation needs to be supported by a particular section in the specification in order to comply with the written description requirement.

### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 55-63 and 70-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70 recites "output said database". It is unclear as to what the outputting of a database really means. Based on the 112 first paragraph rejection for failing to comply with the written description requirement, examiner is uncertain as to how the method step of outputting the database would be performed. For purposes of examination, examiner will assume that it is intended to output data from the database.

Claim 55 recites "the identified data". There is insufficient antecedent basis for this limitation in the claim.

### Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 36-45, 55-65, 67-71 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the

method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyeret al-http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 46, 48 and 53-54 are rejected under 35 U.S.C. 102(b) as being anticipated by "How to sort out the premium drivers of post-deal value" by Daniel W. Bielinski (further referred to as Bielinski).

Regarding claim 46, Bielinski discloses a program storage device readable by a computer, tangibly embodying a program of instructions executable by a computer to perform an element method (pages 1-7), comprising:

Preparing data representative of an enterprise for use in processing, transforming at least a portion of the data into a causal model of each of one or more categories of an organization value (pages 1-7) that identify and output a tangible contribution of each of one or more elements of value (page 1, section 1; page 2, sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6) to a current operation and a real option category of value (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5), and

reporting the value contribution of the elements of value using an electronic display or a paper document (page 1, section 1; page 3, section 10; page 4, sections 4 and 6-7).


Regarding claim 48, Bielinski discloses where a tangible value contribution for each of one or more elements of value to each of one or more categories of value further comprises a direct element contribution to a category of value net of any element of value impacts on other elements of value (page 1, section 2; page 2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page 6, sections 5-6).

Regarding claim 53, Bielinski discloses where the calculated value for each

element of value further comprises a value for a point in time within a sequential series

of points in time (page 1, section 1; page 2, section 1; page 6, section 5).


Regarding claim 54, Bielinksi discloses wherein the net relative contribution for

each element of value to each category of value further comprises a net causal

contribution (page 1, section 2; page 2, section 1; page 3, sections 7-9; page 4, sections

1-4, 7; page 5, section 1; page 6, sections 5-6).


### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating
   obviousness or nonobviousness.

Claims 36-39, 41-43, 45, 55 and 58-63 is rejected under 35 U.S.C. 103(a) as

being unpatentable over "How to sort out the premium drivers of post-deal value" by

Daniel W. Bielinski (further referred to as Bielinski), and further in view of "The 1986-88

stock market: investor sentiment or fundamentals?" by Baur, Quintero and Stevens

(further referred to as Baur).


Regarding claim 36, Bielinski discloses a computer implemented enterprise

method (pages 1-7), comprising:

Preparing data representative of an enterprise for use in processing, and

transforming at least a portion of the data into a model of an enterprise market value by

an element and category of value by completing a series of multivariate analyses that

utilizes said data (pages 1-7),

Where the categories of value are selected from the group consisting of current

operation, real option and combinations thereof (page 1, section 2; page 2, section 7;

page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Where the model of enterprise market value identifies and outputs a tangible

contribution of each element of value to each category of value (page 1, section 1; page

2, sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7;

page 6, sections 1-6).

Bielinski does not disclose where the elements of value are selected from the

group consisting of alliances, brands, channels, customers, employees, intellectual

property, partnerships, processes, vendors and combinations thereof.  However,

Bielinksi does disclose where the elements of value are selected from alliances, employees, partnerships, processes and vendors (page 3, sections 1-5; page 4, sections 4-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further elements of value as are known to be a part of a group in the art.

Bielinski does not disclose where a category of value is market sentiment. However, Baur discloses where a category of value is market sentiment (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and pricing/value factor as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.


Regarding claim 37, Bielinski does not disclose completing activities from the group consisting of the full list of activities as cited. However, Bieliski discloses completing activities from the group such as: completing an analysis of enterprise financial performance, optimizing one or more aspects of enterprise financial performance, simulating an enterprise financial performance, optimizing a future enterprise market value, quantifying a future enterprise market value, creating a

management report valuing a real option, and combinations thereof (pages 1-5).  It is

noted that the claim is set forth as a Markush claim and as such each of the items within

the set are admittedly within a group known in the art.  Therefore it would be obvious to

provide further completion of activities as are known to be a part of a group in the art.


      Regarding claim 38, Bielinski discloses identifying one or more changes that will

optimize one or more aspects of financial performance (pages 1-7).  Bielinski does not

disclose where the aspects of financial performance are selected from the group

consisting of revenue, expense, capital change, cash flow, real option value, future

market value, market sentiment value, market value and combinations thereof.

However, Bielinski discloses where aspects of financial performance are selected from

the group such as: revenue, expense, cash flow, real option value, future market value,

market value and combinations thereof (pages 1-7).  It is noted that the claim is set forth

as a Markush claim and as such each of the items within the set are admittedly within a

group known in the art.  Therefore it would be obvious to provide further aspects of

financial performance as are known to be a part of a group in the art.


      Regarding claim 39, Bielinski does not disclose where a series of multivariate

analyses are selected from the group consisting of the full list as cited in the claim.

However, Bielinski discloses where a series of multivariate analyses are selected from

the group such as identifying one or more previously unknown relationships between

one or more value drivers, identifying one or more previously unknown relationships

between one or more elements of value, quantifying one or more inter-relationships

between value drivers, quantifying one or more impacts between elements of value,

determining a net impact for each category of value, calculating one or more real option

values, and combinations thereof (pages 1-7). It is noted that the claim is set forth as a

Markush claim and as such each of the items within the set are admittedly within a

group known in the art. Therefore it would be obvious to provide further multivariate

analyses as are known to be a part of a group in the art.


     Regarding claim 41, Bielinksi does not disclose wherein data representative of an

enterprise are obtained from systems selected from the group consisting of the full list

as cited in the claim. However, Bielinski discloses wherein data representative of an

enterprise are obtained from systems selected from the group such as advanced

financial systems, basic financial systems, process management systems, supply chain

management systems, vendor management systems, operation management systems,

sales management systems, human resource systems, accounts receivable systems,

accounts payable systems, inventory systems, and combinations thereof (pages 1-7). It

is noted that the claim is set forth as a Markush claim and as such each of the items

within the set are admittedly within a group known in the art. Therefore it would be

obvious to provide further enterprise transaction data as are known to be a part of a

group in the art.

Regarding claim 42, Bielinski discloses using one or more composite applications to complete the processing (page 1, section 1; page 2, section 1; page 3, sections 8-9; page 7, section 6).

Regarding claim 43, Bielinski does not disclose a combination of component and category of value models selected from the group consisting of up to three predictive component value models, a real option discount rate model, a real option valuation model, a market sentiment model by element of value and combinations thereof. Bielisnki discloses a combination of component and category of value models selected from the group consisting of up to three predictive component value models, a real option valuation model, and combinations thereof (pages 1-7). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further models as are known to be a part of a group in the art.

Regarding claim 45, Bielinski discloses identifying one or more changes that will optimize a future market value portion of said enterprise market value (pages 1-7).

Regarding claim 55, Bielinski discloses a computer implemented future market value method (pages 1-7), comprising:

Preparing data representative of an organization for use in processing, transforming at least a portion of the data into a causal model of each of one or more

categories of an organization value (pages 1-7), that calculate and output a tangible

value contribution of each of one or more elements of value to a future market value

and each of the categories of organization value (page 1, section 1; page 2, sections 1

and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6,

sections 1-6)

Where the categories of value comprise a current operation and a real option

category and combinations thereof (page 1, section 2; page 2, section 7; page 3,

sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Bielinski does not disclose where the elements of value are selected from the

group consisting of alliances, brands, channels, customers, customer relationships,

employees, intellectual property, partnerships, processes, vendors and combinations

thereof.  However, Bielinksi does disclose where the elements of value are selected

from alliances, employees, partnerships, processes, vendors and vendor relationships

(page 3, sections 1-5; page 4, sections 4-6).  It is noted that the claim is set forth as a

Markush claim and as such each of the items within the set are admittedly within a

group known in the art.  Therefore it would be obvious to provide further elements of

value as are known to be a part of a group in the art.

Bielinski does not disclose where a category of value is market sentiment.

However, Baur discloses where a category of value is market sentiment (abstract; page

2, "Stock prices and investor sentiment"; page 3, formula 3).  It would be obvious to one

of ordinary skill in the art at the time of the invention to modify the valuation modeling

techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and

pricing/value factor as disclosed by Baur.  The motivation would be that stock price is

calculated based on company value and a company value is derived from real and

intangible assets of value and for most accurate pricing, one would want to incorporate

all assets, real and intangible.


Regarding claim 58, Bielinski discloses where a net relative contribution for each

of one or more elements of value to each of one or more categories of value further

comprises a direct element contribution to a category of value net of any element

impacts on other elements of value within said category of value (page 1, section 2;

page 2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page

6, sections 5-6).


Regarding claim 59, Bielinski does not disclose a plurality of models selected

from the group consisting of predictive component of value models, predictive market

value models, relative element strength models, real option discount rate models, real

option valuation models, market sentiment models and combinations thereof.  Bielisnki

discloses a plurality of models selected from the group consisting of predictive

component of value models, predictive market value models, relative element strength

models, real option valuation models, and combinations thereof (pages 1-7).  It is noted

that the claim is set forth as a Markush claim and as such each of the items within the

set are admittedly within a group known in the art.  Therefore it would be obvious to

provide further models as are known to be a part of a group in the art.

Regarding claim 60, Bielinski discloses where a net contribution for each of one

or more elements of value further comprises a direct contribution to a value of a

category of value net of any impact on other elements of value (page 1, section 2; page

2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page 6,

sections 5-6).


Regarding claim 61, Bielinski discloses where one or more categories of value

are selected from the group consisting of current operation, real option and

combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9;

page 4, section 3; page 6, sections 4-5). Bielinski does not disclose where a category of

value is market sentiment.  However, Baur discloses where a category of value is

market sentiment (abstract; page 2, "Stock prices and investor sentiment"; page 3,

formula 3).  It would be obvious to one of ordinary skill in the art at the time of the

invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt

the use of sentiment as a value driver as disclosed by Baur.  The motivation would be

that stock price is calculated based on company value and a company value is derived

from real and intangible assets of value and for most accurate pricing, one would want

to incorporate all assets, real and intangible.


Regarding claim 62, Bielinski discloses where the future market value portion of

organization market value comprises a summation of values selected from current

operation value, real option value and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5). Bielinski does not disclose market sentiment value. However, Baur discloses market sentiment in valuation (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.

Regarding claim 63, Bielinski does not disclose where the value driver changes that will optimize future market value are identified by algorithms selected from the group consisting of monte carlo algorithms, genetic algorithms, multi criteria optimization algorithms and combinations thereof. However, Bielinski discloses where the value driver changes that will optimize future market value are identified by multi criteria optimization algorithms (page 2, section 1; page 3, sections 7-9; page 4, section 7; page 5, section 1; page 6, sections 5-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further algorithms as are known to be a part of a group in the art.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski.

Regarding claim 47, Bielinski does not disclose where the elements of value are
selected from the group consisting of alliances, brands, channels, customers, customer
relationships, employees, intellectual property, partnerships, processes, production
equipment, vendors and vendor relationships and combinations thereof.  However,
Bielinksi does disclose where the elements of value are selected from alliances,
employees, partnerships, processes, production equipment, vendors and vendor
relationships (page 3, sections 1-5; page 4, sections 4-6).  It is noted that the claim is
set forth as a Markush claim and as such each of the items within the set are admittedly
within a group known in the art.  Therefore it would be obvious to provide further
elements of value as are known to be a part of a group in the art.

Claims 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over
"How to sort out the premium drivers of post-deal value" by Daniel W. Bielinski (further
referred to as Bielinski), in view of "The 1986-88 stock market: investor sentiment or
fundamentals?" by Baur, Quintero and Stevens (further referred to as Baur), and further
in view of US Patent 4,989,141 to Lyons et al. (further referred to as Lyons).

Regarding claim 72, Bielinski discloses An organization system comprising of a
computer with a processor having circuitry to execute instructions, a storage device

available to said processor with sequences of instructions stored therein, which when

executed cause the processor to complete a computer implemented market value

accounting method (pages 1-7), comprising:

Preparing a plurality of data representative of an organization for use in

processing, transforming at least a portion of the data into a model each of one or more

categories of an organization value (pages 1-7), that identify and output a tangible

contribution of each of one or more elements of value to the categories of organization

value by completing a series of analyses (page 1, section 1; page 2, sections 1 and 7;

page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6)

Where the categories of value further comprise a current operation category of

value and a real option category and combinations thereof (page 1, section 2; page 2,

section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Using the tangible contribution for each element of value to identify a market

value for each element of value (page 1, section 1; page 2, sections 1 and 7; page 3,

sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6), and

Reporting the value of each element of value (page 1, section 1; page 3, section

10; page 4, sections 4 and 6-7).

Bielinski does not disclose where a category of value is market sentiment.

However, Baur discloses where a category of value is market sentiment (abstract; page

2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one

of ordinary skill in the art at the time of the invention to modify the valuation modeling

techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and

to calculate stock price using sentiment as disclosed by Baur.  The motivation would be

that stock price is calculated based on company value and a company value is derived

from real and intangible assets of value and for most accurate pricing, one would want

to incorporate all assets, real and intangible.

   Neither Bielinski nor Baur disclose reporting in a balance sheet format and where

the reported value is a value for a specific point in time within a sequential series of

points in time.  However, Lyons discloses reporting in a balance sheet format (column 2,

lines 16-34; column 3, lines 1-10; column 10, lines 1-9; column 16, lines 61-68; column

24, line 50 – column 25, line 12 where it is disclosed that users input data from various

reports such as balance sheets and income statements, the data can be manipulated

and analyzed across departments in an organization, for example, and then a report

can be generated representing data as requested by a user and wherein it would be

obvious that if data is submitted in the form of a balance sheet or income statement,

that data could then be output in the same format) and where the reported value is a

value for a specific point in time within a sequential series of points in time (column 2,

lines 61-66; column 8, lines 56-61).  It would be obvious to one of ordinary skill in the art

at the time of the invention to modify the data analysis of key drivers of market value as

disclosed by Bielinski and Baur to adapt the use of providing reports in balance sheet

format and providing values for a specific point in time across a sequential period of

time as disclosed by Lyons.  The motivation would be that a balance statement provides

key data in understanding market value of an enterprise, and further value is analyzed

and understood at certain points in time relative to a continuum of time.

Regarding claim 73, neither Bielinski nor Baur disclose including a value for one

or more financial assets in a report with a balance sheet format.  However, Lyons

discloses including a value for a plurality of financial assets in a report with a balance

sheet format (column 2, lines 16-34; column 3, lines 1-10; column 10, lines 1-9; column

16, lines 61-68; column 24, line 50 – column 25, line 12) where it is disclosed that users

input data from various reports such as balance sheets and income statements, the

data can be manipulated and analyzed across departments in an organization, for

example, and then a report can be generated representing data as requested by a user

and wherein it would be obvious that if data is submitted in the form of a balance sheet

or income statement, that data could then be output in the same format.  Given the

combination of Bielinski, Baur and Lyons as cited in claim 72 with regards to presenting

data in a balance sheet format, it is further obvious to report multiple values in a balance

sheet format as balance sheets contain various types of data.


Regarding claim 74, neither Bielinski nor Baur specifically disclose tracking a

change in value of each of one or more elements of value over time, and including the

calculated changes in value of each element of value in an income statement or a cash

flow statement.  However, Lyons discloses tracking a change in value of each of one or

more elements of value over time (column 2, lines 58-66; column 8, lines 56-61), and

including the calculated changes in value of each element of value in an income

statement or a cash flow statement (column 2, lines 16-34; column 3, lines 1-10; column

10, lines 1-9; column 16, lines 61-68; column 24, line 50 – column 25, line 12) where it

is disclosed that users input data from various reports such as balance sheets and

income statements, the data can be manipulated and analyzed across departments in

an organization, for example, and then a report can be generated representing data as

requested by a user and wherein it would be obvious that if data is submitted in the form

of a balance sheet or income statement, that data could then be output in the same

format.  Given the combination of Bielinski, Baur and Lyons as cited in claim 72 with

regards to presenting data in a balance sheet format, it is further obvious to report

values over a period of time in traditional financial forms such as an income statement

or cash flow statement format.


        Regarding claim 75, Bielinski does not disclose where the elements of value are

customers and elements of value selected from the group consisting of alliances,

brands, channels, employees, intellectual property, partnerships, processes, vendors

and vendor relationships and combinations thereof.  However, Bielinksi does disclose

where the elements of value are selected from alliances, employees, partnerships,

processes, vendors and vendor relationships (page 3, sections 1-5; page 4, sections 4-

6).  It is noted that the claim is set forth as a Markush claim and as such each of the

items within the set are admittedly within a group known in the art.  Therefore it would

be obvious to provide further elements of value as are known to be a part of a group in

the art.

Claim 64-65 and 67-69 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent 7,249,328 B1 to Davis (further referred to as Davis), and

further in view of "How to sort out the premium drivers of post-deal value" by Daniel W.

Bielinski (further referred to as Bielinski).


Regarding claim 64, Davis discloses a composite application method for data

processing, comprising:

Using two or more independent components of application software to produce

one or more useful results (column 8, lines 23-51; column 9, lines 1-11; column 12, lines

11-56; column 36, lines 59-67; column 37, lines 5-8; column 38, lines 48-56);

by transforming data representative of a physical object or substance with a utility

in managing or monitoring a real world activity of said object or substance (column 8,

lines 23-51; column 9, lines 1-11; column 12, lines 26-56; column 37, lines 5-8; column

38, lines 48-56).

where data has been aggregated from two or more systems (column 8, lines 29-

34; column 10, lines 25-26; column 11, lines 24-27; column 12, lines 26-29 and lines 53-

56; column 28, lines 31-34; column 38, lines 50-53)

in accordance with a common model or schema defined by an xml metadata

standard (column 8, lines 40-46 and lines 52-57; column 10, lines 31-33 and lines 52-

55; column 11, lines 24-66; column 12, lines 45-56; column 13, lines 34-37; column 15,

lines 60-67; column 18, lines 48-54; column 26, lines 65-67; column 27, lines 1-5;

column 28, lines 31-34; column 30, lines 42-50; column 30, lines 51-60; column 33,

lines 15-47; column 37, lines 5-8; column 38, lines 48-56).

Davis does not disclose where data is transformed into a predictive model.

However, Bielinski discloses where data is transformed into a predictive model (page 1,

section 1; page 2, section 1; page 4, section 2; page 6, section 2).  It would be obvious

to one of ordinary skill in the art to modify the use of graphing and charting of data

received from multiple sources for the purpose of tracking how organizations are

performing, for example, as disclosed by Davis to adapt the use of predictive models as

disclosed by Bielinski.  The motivation would be that as historic and current data is

obtained and useful for understanding what has occurred in the far or recent past,

businesses are always looking forward and attempting to quantify and understand how

the future value of a company can be maximized, as disclosed by Bielinski, where this

analysis includes both past-, present- and future-looking data.

Regarding claim 65, Davis discloses where the independent components of

application software can be flexibly combined as required to support the development of

one or more useful results (column 8, lines 23-51; column 9, lines 1-11; column 12, lines

11-56; column 36, lines 59-67; column 37, lines 5-8; column 38, lines 48-56).

Regarding claim 67, Davis does not disclose where the independent components

of application software complete processing selected from the group consisting of the

full list as stated in the claim limitation.  However, Davis discloses where the

independent components of application software complete processing selected from the

group such as: analysis, attribute derivation, classification, clustering, data acquisition,

data conversion, data storage, data transformation, keyword match identification, and

combinations there of (column 4, lines 10-45; column 8, lines 24-46; column 8, line 65 –

column 9, line 5; column 9, lines 59-67; column 10, lines 19-53; column 11, lines 24-64;

column 12, lines 15-56; column 13, lines 20-48; column 15, lines 60-67; column 16,

lines 11-15; column 17, lines 7-12 and lines 38-67; column 18, lines 1-67; column 20,

lines 32-38; column 21, lines 26-59; column 23, lines 64-67; column 26, lines 47-67;

column 27, lines 1-21; column 28, lines 31-39; column 30, lines 51-58; column 31, lines

33-50; column 33, lines 28-47; column 36, lines 59-67; column 37, lines 5-8; column 38,

lines 48-65; column 45, lines 1-14; column 49, lines 19-48; column 50, lines 38-49).  It is

noted that the claim is set forth as a Markush claim and as such each of the items within

the set are admittedly within a group known in the art.  Therefore it would be obvious to

provide further processes as are known to be a part of a group in the art.


     Regarding claim 68, Davis does not disclose where the useful results are

selected from the group consisting of the full list as stated in the claim limitation.

However, Davis discloses where the useful results are selected from the group such as:

enterprise financial performance analysis, management reporting, share price valuation,

sub-element clustering and combinations thereof (column 8, lines 36-51; column 9, lines

59-67; column 10, lines 31-53; column 11, lines 52-62; column 12, lines 26-56; column

45, lines 1-14 and lines 40-50; column 49, lines 20-42).  It is noted that the claim is set

forth as a Markush claim and as such each of the items within the set are admittedly

within a group known in the art.  Therefore it would be obvious to provide further useful

results as are known to be a part of a group in the art.


Regarding claim 69, Davis does not disclose where two or more systems are

selected from the group consisting of the full list as stated in the claim limitation.

However, Davis discloses where the enterprise management systems are selected from

the group such as: accounts receivable systems, accounts payable systems, advanced

financial systems, basic financial systems, process management systems, operation

management systems, sales management systems, capital asset systems, inventory

systems, the Internet, external databases and combinations thereof (column 8, lines 24-

51; column 9, lines 59-67; column 10, lines 31-53; column 11, lines 52-62; column 12,

lines 26-56; column 45, lines 1-14 and lines 40-50; column 49, lines 20-42).  It is noted

that the claim is set forth as a Markush claim and as such each of the items within the

set are admittedly within a group known in the art.  Therefore it would be obvious to

provide further systems as are known to be a part of a group in the art.


Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis,

and further in view of US Patent 6,549,922 B1 to Srivastava et al. (further referred to as

Srivastava).

Regarding claim 70, Davis discloses a computer implemented data processing method, comprising:

Integrating, converting and storing data representative of an organization from a plurality of disparate sources (column 8, lines 29-34; column 10, lines 25-26; column 11, lines 24-27; column 12, lines 26-29 and lines 53-56; column 28, lines 31-34; column 38, lines 50-53) in accordance with a common xml schema (column 8, lines 40-46 and lines 52-57; column 10, lines 31-33 and lines 52-55; column 11, lines 24-66; column 12, lines 45-56; column 13, lines 34-37; column 15, lines 60-67; column 18, lines 48-54; column 26, lines 65-67; column 27, lines 1-5; column 28, lines 31-34; column 30, lines 42-50; column 30, lines 51-60; column 33, lines 15-47; column 37, lines 5-8; column 38, lines 48-56) to transform said data into an integrated database and output said [database – data per 112] (column 11, lines 15-64; column 12, lines 45-56; column 13, lines 18-40; column 15, lines 23-42; column 16, lines 11-15; column 26, lines 47-67; column 49, lines 20-28)

Where metadata mapping is guided by a metadata mapping table (column 10, lines 19-53; column 11, lines 24-64; column 12, lines 45-56; column 15, lines 60-67; column 18, lines 2-14; column 20, lines 32-38; column 21, lines 26-61; column 30, lines 51-58; column 33, lines 28-47; column 49, lines 19-47; column 50, lines 38-45);

Davis does not disclose where a metadata and conversion rules window is used to establish a metadata mapping table.  However, Srivastava discloses where a metadata and conversion rules window is used to establish a metadata mapping table (Figure 2; column 3, lines 27-62; column 5, lines 14-18; column 6, lines 15-18; column

7, lines 27-31). It would be obvious to one of ordinary skill in the art at the time of the

invention to modify the use of metadata mapping tables as disclosed by Davis to

provide a window for establishing the tables as disclose by Srivastava. The motivation

is that GUIs use windows for providing a user interface for such functions as defining a

metadata table and it would be obvious to use a commonly known technique for

establishing tables, namely the providing of a window, as disclosed by Srivastava.


Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis

and Srivastava as applied to claim 70 above, and further in view of "Building customer

and shareholder value" by A. Cleland and A. Bruno (further referred to as Cleland).


Regarding claim 71, Davis discloses where each of one or more tables in an

application database further comprise one axis that is defined by one or more time

periods that require data (Figure 14A-F, 15B-C, 16-17, 20A-D, 22A-B).

Neither Davis nor Srivastava disclose another axis that is defined by one or more

data categories selected from the group consisting of components of value, sub-

components of value, known value drivers, elements of value, non-relevant attributes

and combinations thereof. However, Cleland discloses another axis that is defined by

one or more data categories selected from the group such as components and

elements of value and known value drivers (Exhibits 1-5 and related text). It would be

obvious to one of ordinary skill in the art at the time of the invention to modify the use of

analysis and charting of key financial figures using metadata as disclosed by Davis and

Srivastava to adopt the charting of value as disclosed by Cleland. The motivation would

be that charts provide a visual representation of data which is often more meaningful

than the raw data itself for drawing conclusions about the data, such as if one were

reviewing data related to customer and/or stockholder value as disclosed by Cleland. It

is further noted that the claim is set forth as a Markush claim and as such each of the

items within the set are admittedly within a group known in the art. Therefore it would

be obvious to provide further processes as are known to be a part of a group in the art.


Claims 44 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Bielinski and Baur as applied to claims 36 and 55 above, and further in view of

Davis.


Regarding claim 44, neither Bielinksi nor Baur disclose where preparing

transaction data for use in processing further comprises integrating said data in

accordance with a common schema where the common schema is defined by a

COBRA metadata or an xml metadata. However, Davis discloses where preparing

transaction data for use in processing further comprises integrating said data in

accordance with a common schema where the common schema is defined by a

COBRA metadata or an xml metadata (column 8, lines 40-46 and lines 52-57; column

10, lines 31-33 and lines 52-55; column 11, lines 24-66; column 12, lines 45-56; column

13, lines 34-37; column 15, lines 60-67; column 18, lines 48-54; column 26, lines 65-67;

column 27, lines 1-5; column 28, lines 31-34; column 30, lines 42-50; column 30, lines

51-60; column 33, lines 15-47; column 37, lines 5-8; column 38, lines 48-56) to support

organization processing (column 8, lines 29-34 and lines 40-51; column 9, lines 1-6;

column 10, lines 19-30; column 12, lines 15-17; column 13, lines 19-23; column 25,

lines 53-60; column 26, lines 47-67; column 28, lines 31-40; column 36, lines 59-67;

column 37, lines 5-12; column 38, lines 48-65). It would be obvious to one of ordinary

skill in the art at the time of the invention to modify the data analysis for value drivers as

disclosed by Bielinksi and Baur to adapt the use of integrating data using xml metadata

as disclosed by Davis. The motivation would be that to understand the overall value of

an enterprise, it would be advantageous to gather data from various groups and

departments and providing a common schema for doing so creates a more efficient

means of sharing data, as disclosed by Davis.


Regarding claim 57, neither Bielinski nor Baur disclose the use of a flexible

system architecture where said architecture further comprises event data that has been

integrated in accordance with a common xml schema and independent components of

application software that can be combined to process said data as required to produce

useful results. However, Davis discloses the use of a flexible system architecture where

said architecture further comprises event data that has been integrated in accordance

with a common xml schema and independent components of application software that

can be combined to process said data as required to produce useful results (column 8,

lines 40-46 and lines 52-57; column 10, lines 31-33 and lines 52-55; column 11, lines

24-66; column 12, lines 45-56; column 13, lines 34-37; column 15, lines 60-67; column

18, lines 48-54; column 26, lines 65-67; column 27, lines 1-5; column 28, lines 31-34;
column 30, lines 42-50; column 30, lines 51-60; column 33, lines 15-47; column 37,
lines 5-8; column 38, lines 48-56)  It would be obvious to one of ordinary skill in the art
at the time of the invention to modify the data analysis for value drivers as disclosed by
Bielinksi and Baur to adapt the use of integrating data using xml metadata as disclosed
by Davis.  The motivation would be that to understand the overall value of an enterprise,
it would be advantageous to gather data from various groups and departments and
providing a common schema for doing so creates a more efficient means of sharing
data, as disclosed by Davis.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski
and Baur as applied to claim 39 above, and further in view of US Patent 6,192,354 B1
to Bigus et al. (further referred to as Bigus).

Regarding claim 40, neither Bielisnki nor Baur disclose wherein a predictive
model algorithm is selected from the group consisting of neural network; classification
and regression tree; generalized autoregressive conditional heteroskedasticity;
regression; generalized additive; redundant regression network; rough-set analysis;
Bayesian; multivariate adaptive regression spline and support vector method.  However,
Bigus discloses wherein a selected predictive model algorithm is Bayesian (column 12,
lines 40-65; column 12, lines 28-33).  It would be obvious to one of ordinary skill in the
art at the time of the invention to modify the use of optimization using predictive models

as disclosed by Bielinksi and Baur to adapt the optimization of tasks using a Bayesian

predictive algorithm as disclosed by Bigus.  The motivation would be to use a well

known algorithm which enables machine learning in order to improve the predictive

results.


Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski

as applied to claim 46 above, and further in view of US Patent 5,245,696 to Stork et al.

(further referred to as Stork).


Regarding claim 50, Bielinski does not disclose where the element of value

contributions are identified by learning from the data However, Stork discloses learning

from data.  It would be obvious to one of ordinary skill in the art at the time of the

invention to modify the predictive modeling for optimization as disclosed by the Bielinksi

to adapt the use of learning from the data, such as through genetic algorithms, as

disclosed by Stork.  The motivation would be to provide a means by which the modeling

would continue to make better optimizations based on data and feedback.


Claims 49 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Bielinski as applied to claim 46 above, and further in view of "Get Real: using real

options in security analysis" by Michael J. Mauboussin of Credit Suisse First Boston

(further referred to as Mauboussin).

Regarding claims 49 and 51, Bielinksi discloses identifying one or more elements of value that make a casual contribution to an organization market value (pages 1-7).

Bielinski does not disclose computing a difference between a real option value calculated using the company cost of capital as the discount rate and a value calculated using a real option discount rate comprised of a base discount rate plus a risk factor for each element of value that makes a causal contribution to organization market value; and assigning the value difference to the different elements of value based on their relative contribution to a calculated difference in the two discount rates. However, Mauboussin discloses calculating the difference between real option value using current equity value and discounted cash flow analysis (page 3, section 8; page 15, sections 1-2 and 6) in order to capture the value of real options (page 4, section 1; page 13, section 5) where an evaluation of risk and the difference in value when including real options is allocated to an investment potential (page 5, sections 4-6; page 15, sections 2 and 6) such that an understanding between disparities between discounted cash flows and stock prices can be understood (page 8, section 3; page 13). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation of real options as disclosed by Bielinski to adapt the computational techniques as disclosed by Mauboussin. The motivation would be to use mathematical techniques which have been determined to best capture the value of real options as an enterprise considers their overall value and conducts stock price analysis.

Regarding claim 52, Bielsinki discloses identifying one or more value drivers for each element of value (pages 1-7), developing one or more element impact summaries from said value drivers for market value and each component of value (page 1, sections 1-2; page 2, sections 1 and 7; page 3, sections 7-9; page 4, sections 1-4 and 7), identifying a best fit combination of element impact summaries and predictive model algorithm for modeling market value and each component of value (page 2, section 1; page 3, sections 7-9; page 4, sections 4 and 7; page 5, section 1; page 6, section 5-6), determining a relative strength for each of the elements of value change vis a vis competitors (page 2, section 1; page 3, sections 7-9; page 4, sections 4 and 6-7), calculating a real option value, identifying a net element contribution to enterprise market value by category of value by combining the results from the processing of steps above (page 3, sections 7-9; page 4, sections 6-7; page 5, section 1; page 6, sections 3-6).  Bielinski does not disclose calculating a real option discount rate and calculating the real option value using the discount rate.  However, Mauboussin discloses calculating a real option discount rate and calculating the real option value using the discount rate (page 4, section 1; page 5, sections 4-6; page 8, section 3; page 15, sections 1-2 and 6).  It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation of real options as disclosed by Bielinski to adapt the computational techniques as disclosed by Mauboussin.  The motivation would be to use mathematical techniques which have been determined to best capture the value of real options as an enterprise considers their overall value and conducts stock price analysis.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski and Baur as applied to claim 55 above, and further in view of "Get Real: using real options in security analysis" by Michael J. Mauboussin of Credit Suisse First Boston (further referred to as Mauboussin).

Regarding claim 56, Bielinksi discloses identifying one or more elements of value that make a casual contribution to an organization market value (pages 1-7).

Neither Bielinski nor Baur disclose wherein the discount rate for a real option valuation comprises a base discount rate plus a risk factor for each element of value that is causal to organization market value. However, Mauboussin discloses calculating the difference between real option value using current equity value and discounted cash flow analysis (page 3, section 8; page 15, sections 1-2 and 6) in order to capture the value of real options (page 4, section 1; page 13, section 5) where an evaluation of risk and the difference in value when including real options is allocated to an investment potential (page 5, sections 4-6; page 15, sections 2 and 6) such that an understanding between disparities between discounted cash flows and stock prices can be understood (page 8, section 3; page 13). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation of real options as disclosed by Bielinski and Baur to adapt the computational techniques as disclosed by Mauboussin. The motivation would be to use mathematical techniques which have been determined to

best capture the value of real options as an enterprise considers their overall value and

conducts stock price analysis.

### *Response to Arguments*

A recent ruling from the Board regarding 35 U.S.C. 101 has resulted in the new

101 rejection as set forth above and accordingly this decision has prompted the Non-

Final Office Action as contained herein.

With regards to applicant's arguments for the rejections of claims 64 and 65,

examiner notes that claims 64 and 65 are now rejected under 35 U.S.C. 103 as a result

of the newly added claim limitations. Applicant argues that with regards to claims 64

and 65 that the Davis reference fails to disclose "data integration, metadata mapping

and outputting an integrated database". Claim 64 refers to data being aggregated from

two or more systems. The examiner finds that Davis clearly shows where data is

aggregated from two or more systems as Davis specifically discloses data being

obtained from a variety of sources and then subsequently being used in processing

operations, as detailed in the Office Action above. Claim 64 refers to data being

aggregated by an xml metadata standard. Again, as detailed in the Office Action above,

Davis specifically discloses the use of an xml metadata standard for the aggregating of

data received from the multiple sources. Claim 64 fails to recite outputting an integrated

database and this argument is therefore mute.

Applicant argues that the 35 U.S.C. 103 rejections are improper, namely that the

cited combination of references 1) fail to establish a prima facia case of obviousness by

teaching away from elements of the claimed invention and by failing to teach every

limitation of the claims, and 2) that the rejections are not in compliance with APA

standards.

With regards to Applicants claim that the rejections fail under APA standards,

Examiner believes that the claims have been properly rejected.  Examiner believes that

the rejections as set forth in the Office Actions have addressed each claim limitation

using prior art which addresses the claim limitations and that where any combinations of

prior art were used to reject claims that  proper evidence and motivation for such a

combination has been provided.  Therefore the Examiner asserts that both standards of

the APA have been followed and that the Office Action is proper with respect to the

evidence provided in rejecting the claims.

With regards to the argument that the cited combination does not teach or

suggest one or more limitation for every rejected claim, Examiner contends that the

rejection of the claim limitations as presented in the claims is thorough and proper in

addressing each limitation contained therein.

Applicant argues the use of Lyons but does not point out how Lyons fails to

disclose the claim limitations.  Applicant states that Lyons teaches a method for

manipulating financial schedule information while the present application analyzes data

that describe the physical operation of a business using a predefined process.  While

this language may generally address the teachings of Lyons and the present

application, examiner notes that this language is not within the claims.  A similar finding

is made with respect to the arguments made regarding the Srivastave and Bauer

reference. Examiner contends that the claim language has been properly analyzed and that the references as cited teach the claim language as presented.

With regards to applicant's arguments of the Davis reference, the arguments fail to reflect language in the claims. For example, it is noted in the Remarks that "Davis reinforces the previously disclosed teachings of Bergstrom and Widom that the limitations of dtd's that make them generally unsuitable for use in enterprise processing. Davis does this by teaching the use of xml for formatting of data for graphs and tables." While Davis discloses the use of xml for formatting of data for graphs and tables, Davis does not teach that xml can not be useful for other applications. As detailed in the Office Action above, Davis discloses where data is received from a variety of sources and stored in a database for processing and examiner therefore contends that the Davis reference is relevant in the rejection of the present application.

With regards to the Bielinski reference, applicant claims that the reference teaches away from the claimed methods. However, it is noted that the standard by which teaching away is determined is based on the prior art references specifically criticizing, discrediting, or otherwise discouraging the use or implementation of an method, process, etc. The teaching of alternative methods or processes does not constitute teaching away, as noted in case law as set forth in the MPEP 2123 II: "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed…." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Applicant argues that Examiner has failed to explain the rationale for combining the teachings of the cited documents. However, in each instance of combination, the reason for the combination has been provided in terms of which limitations are taught by which reference, and a motivation for the combination has been provided. Examiner believes that proper combinations have been made and proper motivations and rationales set forth within the claim rejections. The courts have found that "A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45." In re Kahn, 78 USPQ2d 1329, 1336 (CA FC 2006). XXXXX "It is, of course, not necessary that either [prior art references] actually suggest, expressly or in so many words, the changes or possible improvements appellant has made." In re Sheckler, 168 USPQ 716, 717 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that "[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references...The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (emphasis added) In re Kahn, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that "articulated reasoning" to support the legal conclusion of obviousness has been made.

Finally, examiner acknowledges the Request for Correction contained within the Remarks submission.  Examiner believes that a proper and thorough evaluation of the claims has been conducted, and that the prior art has been properly cited, following all applicable laws.  Examiner contends that in no way is there any attempt or "effort to justify the allowance of a number of apparently invalid patents to large companies" as contemplated by the applicant.

### Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167.  The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702.  The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.  Status information for published applications may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished applications is available through Private PAIR only.  For more information about the PAIR system, see <http://pair-direct.uspto.gov>.  Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Examiner, Art Unit 3692